

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDERICK W. NELSON, KENT R. HAWK,
TERENCE D. PICKETT, WAYNE F. SMITH

Appeal No. 1999-1113
Application No. 08/888,354

ON BRIEF

Before KRASS, JERRY SMITH and BLANKENSHIP, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7, all of the pending claims.

The invention is directed to a grain moisture sensor for an agricultural combine and is best illustrated by reference to representative independent claim 1 reproduced as follows:

1. A moisture sensor for an agricultural combine having a clean grain elevator, the moisture sensor comprising:

a vertically extending chamber mounted to the clean grain elevator, the chamber having an upper inlet and a lower outlet, clean grain enters the chamber from the clean grain elevator through the inlet and exits the chamber back into the clean grain elevator through the outlet;

a capacitance sensing means is positioned in the chamber between the outlet and the inlet, the capacitance sensing means senses the capacitance of clean grain in the chamber and provides a capacitance signal that can be related to grain moisture;

a flow control means for controlling the flow of clean grain through the chamber.

The examiner relies on the following reference:

Oetiker et al. (Oetiker)	4,547,725	Oct. 15, 1985
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Instant claim 7, added by amendment on July 30, 1997, corresponds to claim 1 of U.S. Patent 5,616,851.

Claims 1-6 stand rejected under 35 U.S.C. § 103 as unpatentable over Oetiker.

Claim 7 stands rejected under 35 U.S.C. § 112, first paragraph, as relying on an inadequate written description, the examiner taking the position that “[c]laim 7 has no support in the original specification.”

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

Turning first to the rejection of claims 1-6 under 35 U.S.C. § 103, we will not sustain this rejection because the examiner has failed to establish a prima facie case of obviousness.

The examiner's rejection, in toto, states that the claims are rejected under 35 U.S.C. § 103 "as obvious over the teachings of the Oetiker reference when extended to sensors mounted on combines."

It is true that Oetiker discloses a moisture sensor for grain and that the sensor employs a capacitance sensing means positioned in a chamber for sensing the capacitance of grain and providing a capacitance signal that can be related to grain moisture. Oetiker also discloses a flow control means for controlling the flow of grain through the chamber.

Even though the examiner provides no explanation of the rejection until the response section of the answer, explaining that the functional behavior of the sensor is not dependent on where it is mounted, in recognition of Oetiker's failure to disclose an agricultural combine, we might sustain the rejection if the recitation of the agricultural combine were merely an intended use. However, independent claims 1 and 6 recite very specific structure in the recitation of a "clean grain elevator" and that "clean grain

elevator” is an integral part of the claimed structure since the chamber must be mounted to the elevator, the clean grain must enter the chamber from the clean grain elevator and must exit the chamber back into the clean grain elevator. Accordingly, in order to find the claimed subject matter obvious, within the meaning of 35 U.S.C. § 103, the examiner would need to provide some evidentiary showing as to why it would have been obvious to modify the Oetiker teaching of a capacitive moisture sensor so as to connect such a sensor to a clean grain elevator in a combine in the manner claimed. The examiner has made no such showing. Thus, we will not sustain the rejection.

While we need not reach the merits of the rejection of claims 4 and 5 since we find claim 1 to be unobvious based on the evidence provided by the examiner, we would also note that while appellants argue the merits of claim 4, pointing out that the specific structure of a paddle wheel is recited as being the claimed “flow control means,” the examiner is totally silent as to this specific limitation.

We now turn to the rejection of claim 7 under 35 U.S.C. § 112, first paragraph.

We also will not sustain this rejection.

At the outset, we note that the examiner has failed to provide a reasonable basis for contesting the adequacy of the written description of the instant specification. The examiner's rejection of claim 7, in toto, states that “[c]laim 7 has no support in the

original specification. The only support for claim 7 consists of the amended specification text introduced in paper 13.”

A rejection which fails to mention what portion or portions of the claim are considered to lack support is unreasonable, and hence defective, on its face. Nevertheless, appellants provide a thorough analysis of the claim, at pages 6-7 of the brief, indicating where, in the original specification, each portion finds support. The examiner completely ignores appellants’ argument, failing even to refer to the rejection of claim 7 in the response section of the answer.

As best as can be gleaned from the examiner’s comments in the final rejection and in the action of October 1, 1997, the examiner appears to take the view that any terms that were not present *verbatim* in the original disclosure can have no support when attempting to amend the specification to include such terms. The examiner specifically mentions no support for the “feed means” now recited in claim 7. However, as explained by appellants, at page 7 of the brief, while the original disclosure did not use the term, “feed means,” it is very clear that the originally disclosed paddle wheel which forms the control means for retaining grain in the chamber is a “feed means.”

It appears that the examiner is attempting to find and match the exact words of the claims with words or phrases within the original disclosure. However, if the specification contains a description of the claimed invention, albeit not in ipsis verbis (in the identical words), then the examiner, in order to meet the burden of proof, must provide reasons why one of ordinary skill in the art would not consider the description sufficient. In re Alton, 76 F.3d 1168, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). It is enough that the original disclosure makes clear that the applicants had possession of the invention now claimed at the time the application was originally filed. We hold that it is clear, in the instant case, that appellants did, indeed, have such possession.

Moreover, while appellants painstakingly went through the major elements of the claim and pointed out specifically the support for each one in the original disclosure, the examiner has not rebutted appellants' position at all.

The examiner has provided no reasonable basis for attacking the adequacy of the written description of the instant disclosure with regard to claim 7. Accordingly, we will not sustain the rejection of this claim under 35 U.S.C. § 112.

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The examiner's decision rejecting claims 1-6 under 35 U.S.C. § 103 and claim 7 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JERRY SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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